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MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202			MACKEY, PATRICK HEWEY	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/747,840
Filing Date: December 29, 2003
Appellant(s): GRAUSHAR ET AL.

Billie Jean Smith
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 23, 2005 appealing from the Office action mailed April 21, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,388,815	Hill et al.	2-1995
6,431,453	Hill et al.	8-2002
6,126,201	Pace et al.	10-2000

5,114,128

Harris, Jr. et al.

5-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3, 6, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al. (US 5,388,815). Hill discloses a method that includes writing electronic information to an optical disk (30) on a binding line (20), reading information from an optical disk (30) on a binding line (57), and associating the disk with a product printed (26) with personalized indicia.

Claims 11, 13, 14, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill et al. (US 6,431,453). Hill discloses a method that includes reading electronic information from an optical disk (32, 44, or 46) on a binding line (76), and associating the optical disk with a printed product (104).

Claims 1-3, 6-7, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace et al. in view of Hill et al. (US 5,388,815). Pace discloses a method for associating a CD with a printed product, but it does not disclose writing and reading electronic information on a binding line. However, Hill discloses writing and reading electronic information on a binding line for the purpose of delivering owner specific electronic media to an account owner. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Pace by writing electronic information on a binding line for the purpose of delivering owner specific electronic media to an account owner.

Claims 4 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pace et al. in view of Hill et al. (US 5,388,815) as applied to claim 6 above, and further in view of

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Harris, Jr. et al. Pace and Hill together disclose all the limitations of the claims, but it doesn't disclose printing personalized indicia in response to what was read from the optical disk after associating. However, Harris, Jr. discloses a similar method that includes printing personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to print personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hill et al. (US 6,431,453) in view of Harris, Jr. et al. Hill discloses all the limitations of the claims, but it doesn't disclose printing personalized indicia in response to what was read from the optical disk after associating. However, Harris, Jr. discloses a similar method that includes printing personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to print personalized indicia in response to read electronic information after associating for the purpose of printing proper address labels on a printed product.

(10) Response to Argument

Claims 1, 3, 6, and 21-22 Are Anticipated By Hill '815 Under 35 U.S.C. § 102

Claim 1

The appellant states that Hill '815 does not teach or suggest writing information to an optical disk on a binding line as required by claim 1. According to the appellant, the term

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“optical disk”, as defined in the specification, refers to storage devices such as CDs and DVDs as opposed to cards having magnetic strips. The examiner disagrees with the appellant. Hill ‘815 discloses writing electronic information to an optical disk (card 30, see at least col. 5, lines 42-50) on a binding line (10) as well as reading information from the disk (see at least col. 9, lines 30-35 and col. 10, line 21 – col. 11, line 13). The examiner notes that although claims are interpreted in light of the specification, limitations from the specification are not automatically read into the claims. In this case, defining the term “optical disk” as a CD or DVD would render the claims indefinite. The examiner notes that claim 2, which depends from claim 1, states, “the optical disk includes at least one of a CD, CD-ROM, and DVD.” Since claim 2 limits the term “optical disk” to a CD, CD-ROM, or DVD, the term “optical disk” in claim 1 must be broader and encompass other storage mediums. Moreover, the appellant has not disclosed any characteristics about CDs or DVDs that distinguish them from any other storage device. Therefore any storage device, including cards with magnetic strips, read on the term “optical disk” as recited in claims 1 and 6

Claim 3

The appellant states that Hill ‘815 does not disclose printing personalized indicia on the printed product in response to what was written to the optical disk as required by claim 3. According to the appellant, the carrier form disclosed by Hill ‘815 is not printed based on any information on the card, and claim 3 requires utilizing the information written to the disk to print the personalized indicia. The examiner disagrees with the appellant. Hill ‘815 discloses printing personalized indicia on the printed product in response to what was written to the optical disk (see at least col. 7, lines 47-64). Hill discloses a relationship between the information written to

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the disk and information printed on the product. If the information to be written to the disk changes, different information would be printed on the product. Hill discloses printing personalized indicia on the printed product in response to what was written to the optical disk as required by claim 3.

Claim 6

The appellant states that Hill '815 does not disclose reading electronic information from an optical disk on a binding line because, as the appellant previously stated regarding claim 1, Hill '815 does not disclose an optical disk. The examiner disagrees with the appellant. As discussed above regarding claim 1, the electronic information carrier disclosed by Hill '815 reads on claim 3.

Claim 21

The appellant states that Hill '815 does not disclose delivering a plurality of printed products to a binding line based upon information written to an optical disk as recited in claim 21, because Hill '815 does not disclose magazines personalized to the recipient based upon a combination of signatures delivered to the binding line (i.e., selective binding). The examiner disagrees with the appellant. Claim 21 does not recite a magazine personalized to the recipient based upon a combination of signatures delivered to the binding line. Rather, claim 21 recites delivering a plurality of printed products to a binding line based upon information written to an optical disk. Hill '815 discloses delivering a plurality of printed products to a binding line based upon information written to an optical disk (see at least col. 12, lines 50-67 and col. 7, lines 47-64). Hill discloses a relationship between the information written to the disk and information printed on the product. If the information to be written to the disk changes, different products

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with different information are delivered to be bound. Hill discloses delivering a plurality of printed products to a binding line based upon information written to an optical disk written to the optical disk as required by claim 21.

Claim 22

The appellant states that Hill '815 does not disclose delivering a plurality of printed products to a binding line based upon information read from an optical disk as recited by claim 22. The examiner disagrees with the appellant. Hill discloses reading information from an optical disk (see at least col. 9, lines 30-35). If the information from the printed products (26) does not match the information from the optical disk, the optical disk is not bound with the printed products (see at least col. 10, lines 21-40). Therefore, Hill discloses delivering a plurality of printed products to a binding line based upon information read from an optical disk as recited by claim 22.

Claims 11, 13-14, and 22 Are Anticipated by Hill '453 Under 35 U.S.C. § 102.

Claims 11 and 13-14

The appellant states that Hill '453 does not disclose reading electronic information from an optical disk on a binding line, wherein the optical disk has been electronically written offline with respect to the binding line, and associating the optical disk with a printed product on the binding line because Hill '453 does not disclose an optical disk. The examiner disagrees with the appellant. Hill '453 discloses an optical disk (see I.C. chip 32, and bar code 44/46, each of which written offline, carrying electronic information, and being optically read).

Claim 22

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The appellant states that Hill '453 does not disclose reading electronic information from an optical disk on a binding line, delivering printed products to the binding line based upon the information read from the optical disk, and associating the printed products and the optical disk on the binding line. The examiner disagrees with the appellant. Hill '453 discloses that reading data from an optical disk. If the data read from the optical disk and the data from a printed carriers 50 do not match, the optical disk is not associated with the printed carrier (see at least col. 5, lines 1-14). Therefore, Hill '453 discloses reading electronic information from an optical disk on a binding line, delivering printed products to the binding line based upon the information read from the optical disk, and associating the printed products and the optical disk on the binding line as required by claim 22.

Claims 1-3, 6-7, and 21-22 Are Obvious In View of Pace and Hill '815 Under 35 U.S.C.

§ 103.

Claims 1-2

The appellant states that claims 1-2 are not obvious in view of Pace and Hill '815 under 35 U.S.C. § 103 because there is not motivation in the reference to modify the method of Pace such that information is written to an optical disk while on the binding line. The examiner disagrees with the appellant. It would have been obvious for a person of ordinary skill in the art at the time of the appellant's invention to modify Pace by writing electronic information to the optical disk on the binding line for the purpose of delivering owner specific electronic media to an account owner (see at least Hill '815, col. 7, lines 4-20).

Claim 3

The appellant states that Pace and Hill '815 do not disclose the subject matter of claim 3 because Hill '815 does not disclose the act of printing personalized indicia based on what was written to the optical disk. The examiner disagrees with the appellant. Hill '815 discloses printing personalized indicia on the printed product in response to what was written to the optical disk (see at least col. 7, lines 47-64). Hill discloses a relationship between the information written to the disk and information printed on the product. If the information to be written to the disk changes, different information would be printed on the product. Hill and Pace disclose printing personalized indicia on the printed product in response to what was written to the optical disk.

Claims 6-7

The appellant states that claims 6-7 are not obvious in view of Pace and Hill '815 under 35 U.S.C. § 103 because there is not motivation in the reference to modify the method of Pace such that information is read from an optical disk while on the binding line. The examiner disagrees with the appellant. It would have been obvious for a person of ordinary skill in the art at the time of the appellant's invention to modify Pace by reading electronic information from the optical disk on the binding line for the purpose of delivering owner specific electronic media to an account owner (see at least Hill '815, col. 7, lines 4-20).

Claim 21

The appellant states that Pace and Hill '815 do not disclose delivering a plurality of printed products to the binding line based upon information written to an optical disk. The examiner disagrees with the appellant. Hill '815 discloses delivering a plurality of printed products to a binding line based upon information written to an optical disk (see at least col. 12,

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lines 50-67 and col. 7, lines 47-64). Hill discloses a relationship between the information written to the disk and information printed on the product. If the information to be written to the disk changes, different products with different information are delivered to be bound. Hill and Pace disclose delivering a plurality of printed products to a binding line based upon information written to an optical disk written to the optical disk as required by claim 21.

Claim 22

The appellant states Pace and Hill '815 do not disclose delivering a plurality of printed products to the binding line based upon information read from an optical disk. The examiner disagrees with the appellant. Hill discloses reading information from an optical disk (see at least col. 9, lines 30-35). If the information from the printed products (26) does not match the information from the optical disk, the optical disk is not bound with the printed products (see at least col. 10, lines 21-40). Therefore, Hill and Pace discloses delivering a plurality of printed products to a binding line based upon information read from an optical disk as recited by claim 22.

Claims 4 and 8-9 Are Obvious In View of Pace, Hill '815, and Harris Under 35 U.S.C. § 103.

Claim 4

The appellant states that claim 4 is not obvious in view of Pace, Hill '815, and Harris under 35 U.S.C. § 103 because Harris does not disclose printing personalized indicia on a printed product after associating. The examiner disagrees with the appellant. Harris discloses a printer (40) that prints personalized indicia (name and address) on a printed product that has been

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associated with other printed products. Therefore Pace, Hill '815, and Harris disclose printing personalized indicia on a printed product after associating as recited by claim 4.

The appellant also states that there is no motivation to combine the references. The examiner disagrees with the appellant. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to combine the references, to print personalized indicia in response to read electronic information after associating, as disclosed by Harris, for the purpose of printing proper address labels on a printed product.

Claim 8

The appellant also states that Harris does not disclose printing personalized indicia on the printed product in response to what was read from an optical disk because Harris does not disclose an optical disk. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Pace discloses an optical disk.

Claim 9

The appellant states that claim 9 is not obvious in view of Pace, Hill '815, and Harris under 35 U.S.C. § 103 because Harris does not disclose printing personalized indicia on a printed product after associating. The examiner disagrees with the appellant. Harris discloses a printer (40) that prints personalized indicia (name and address) on a printed product that has been associated with other printed products. Therefore Pace, Hill '815, and Harris disclose printing personalized indicia on a printed product after associating as recited by claim 9.

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The appellant also states that there is no motivation to combine the references. The examiner disagrees with the appellant. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to combine the references, to print personalized indicia in response to read electronic information after associating, as disclosed by Harris, for the purpose of printing proper address labels on a printed product.

Claim 12 Is Obvious In View of Hill '453 and Harris Under 35 U.S.C. § 103

The appellant states that claim 12 is not obvious in view of Hill '453, and Harris under 35 U.S.C. § 103 because Harris does not disclose printing personalized indicia on a printed product after associating. The examiner disagrees with the appellant. Harris discloses a printer (40) that prints personalized indicia (name and address) on a printed product that has been associated with other printed products. Therefore Hill '453 and Harris disclose printing personalized indicia on a printed product after associating as recited by claim 12.

The appellant also states that there is no motivation to combine the references. The examiner disagrees with the appellant. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to combine the references, to print personalized indicia in response to read electronic information after associating, as disclosed by Harris, for the purpose of printing proper address labels on a printed product.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted

A handwritten signature in black ink, appearing to be 'PM' with a stylized flourish.

Patrick Mackey

Conferees:

Patrick Mackey

James Bidwell

Gene Crawford

Handwritten initials 'PM' in black ink.Handwritten initials 'JB' in black ink.Handwritten initials 'GC' in black ink.